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STEPHEN P. SWINTON (106398) 1 COOLEY GODWARD LLP 4365 Executive Drive, Suite 1100 2 San Diego, CA 92121-2128 Telephone: (858) 550-6000 3 (858) 453-3555 Facsimile: RECEIVED 4 DOUGLAS E. OLSON (38649) **BROBECK PHLEGER & HARRISON LLP** 5 FEB n1 2001 12390 El Camino Real San Diego, CA 92130 6 Telephone: (858) 720-2500 **TECH CENTER 1600/2900** Facsimile: (858) 720-2555 7 R. WILLIAM BOWEN, JR. (102178) 8 GEN-PROBE INCORPORATED 10210 Genetic Center Drive 9 San Diego, CA 92121-4362 Telephone: (858) 410-8918 10 Facsimile: (858) 410-8637 11 Attorneys for Plaintiff, GEN-PROBE INCORPORATED 12 13 UNITED STATES DISTRICT COURT 14 SOUTHERN DISTRICT OF CALIFORNIA 15 No. 99cv2668 H (AJB) GEN-PROBE INCORPORATED, 16 **DECLARATION OF STEPHEN P. SWINTON IN** Plaintiff, 17 SUPPORT OF GEN-PROBE INCORPORATED'S MOTION FOR LEAVE TO FILE SECOND v. 18 **AMENDED COMPLAINT** VYSIS, INC., 19 February 20, 2001 Date: 10:30 a.m. Defendant. Time: 20 Courtroom 1 Dept.: 21 I, Stephen P. Swinton, declare as follows: 22 I am an attorney at law, licensed to practice before the Courts of the State of 1. 23 California and admitted to practice before this Court. I am a partner in the law firm Cooley 24 Godward LLP, counsel of record for Plaintiff Gen-Probe Incorporated ("Gen-Probe"). I am lead 25 trial counsel for Gen-Probe, and I have been substantially involved in the preparation of this matter 26 for trial. If called as a witness in this matter, I could and would competently testify to the matters 27 28 set forth below: No. 99cv2668 H (AJB) COOLEY GODWARD LLP 265759 v1/SD ATTORNEYS AT LAW 5P2701!.DOC

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- 2. Gen-Probe filed the initial Complaint in this action on December 22, 1999. On January 26, 2000, before Vysis responded to that pleading, Gen-Probe filed its First Amended Complaint. Although Gen-Probe suspected that there existed a factual basis to allege a cause of action for inequitable conduct at this time, Gen-Probe was not then in possession of sufficient facts to plead such a cause of action with the required particularity. A true and correct copy of the First Amended Complaint is attached hereto as Exhibit 1.
- 3. On February 3, 2000, Gen-Probe propounded to Vysis Gen-Probe's First Set of Requests for Production of Documents to Vysis, Inc. ("Document Requests"), a true and correct copy of which is attached hereto as Exhibit 2. When Gen-Probe propounded these document requests, it believed that the requests might unearth documents necessary to confirm that Vysis engaged in inequitable conduct before the patent office.
- 4. On March 8, 2000, Gen-Probe propounded document subpoenas (the "Subpoenas") to BP Amoco, Thomas Banks, Norval Galloway, and Finnegan, Henderson, Farabow, Garrett and Dunner LLP ("Finnegan, Henderson") (collectively the "Third Party Witnesses"). For the most part, the categories of documents sought by the subpoenas were identical the categories of documents sought by Gen-Probe's Document Requests to Vysis. Gen-Probe believed that the Third Party Witnesses possessed documents relevant to the prosecution of United States Patent No. 5,750,338 (the "'338 patent"), which is the patent-in-suit.
- 5. On March 8, 2000, notwithstanding its prior statements to Gen-Probe that Vysis was satisfied with the claims of the '338 patent, Vysis filed a request for reissue of the '338 on the admitted grounds that the patent was "defective."
- 6. On March 9, 2000, Vysis filed a motion encaptioned Motion by Vysis, Inc. For A Stay Of Proceedings And, Alternatively, To Dismiss Count Four Of The First Amended Complaint Under Federal Rule of Civil Procedure § 12(b)(6) ("Motion to Stay"), where Vysis asserted that the litigation should be stayed pending the conclusion of the reissue proceeding that Vysis had initiated the day prior.
- 7. In or about March 2000, the parties stipulated to suspend temporarily their discovery efforts, pending the resolution of the Motion to Stay.

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- On April 10, 2000, Gen-Probe filed its response to the Motion to Stay and therein 8. referred to some of the inequitable conduct theories contained in the [Proposed] Second Amended Complaint that it attached hereto as Exhibit 7. A true and correct copy of Gen-Probe's Memorandum Of Points And Authorities In Support Of Gen-Probe Incorporated's Response To Vysis' Motion: (1) For A Stay Of Proceedings And, Alternatively, (2) To Dismiss Count Four Under Federal Rule Of Civil Procedure 12(b)(6), is attached hereto as Exhibit 3.
  - On April 28, 2000, the Court denied Vysis' Motion to Stay. 9.
  - After the Court denied the Motion to Stay, Gen-Probe resumed its discovery efforts. 10.
- On May 17, 2000, Vysis served its Second Set of Interrogatories Nos. 3-9 to Gen-11. Probe, Incorporated, wherein Vysis included interrogatory number 7, which demanded that Gen-Probe "State in detail each factual and each legal basis for Gen-Probe contention that the '338 patent is unenforceable, including each unenforceability contention advanced by Gen-Probe in briefing on Vysis' motion for a stay of these proceedings." A true and correct copy of Gen-Probe Incorporated's Objections and Responses to Vysis, Inc.'s Second Set of Interrogatories, which sets out the language of this interrogatory, is attached hereto as Exhibit 4.
- On June 7, 2000, the Third Party Witnesses served Gen-Probe with their written 12. responses to the Subpoenas.
- On June 20, 2000, Gen-Probe served its response to Vysis' Second Set of 13. Interrogatories, and, in particular, provided a response to interrogatory number 7. As noted above, a true and correct set of Gen-Probe's responses to Vysis' interrogatories are attached hereto as Exhibit 4.
- Also on June 20, 2000, Vysis served its written responses to Gen-Probe's 14. Document Requests and interrogatories.
- Thereafter, the parties, including the Third Party Witnesses, agreed to endeavor to 15. complete the actual production of responsive documents by mid-November 2000.
- In or about early October 2000, Gen-Probe noticed the depositions of Vysis and BP 16. Amoco's Rule 30(b)(6) designees on issues relating to the prosecution of the various patent applications that led to the '338 (the "Rule 30(b)(6) Patent Prosecution Depositions"). These No. 99cv2668 H (AJB) 265759 v1/SD

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depositions were to be held in late October 2000. Gen-Probe believed that the information it would gather during these depositions would help to confirm its suspicions that Vysis had engaged in inequitable conduct with respect to the '338 patent.

- Several days in advance of the Rule 30(b)(6) Patent Prosecution Depositions, per 17. Gen-Probe's request, Vysis produced to Gen-Probe files it had maintained with respect to the prosecution of several patent applications related to the '338 patent.
- On October 26 and 27, 2001, Gen-Probe deposed Vysis and BP Amoco's 30(b)(6) 18. designee on the prosecution of the '338 patent, Norval Galloway. During the Rule 30(b)(6) Patent Prosecution Depositions, Gen-Probe for the first time learned certain facts contained in the [Proposed] Second Amended Complaint, and confirmed other facts contained therein.
- Although Gen-Probe learned additional facts to support its allegations of 19. inequitable conduct during the Rule 30(b)(6) Patent Prosecution Depositions, Gen-Probe determined that it would be appropriate to defer seeking leave to amend until after Vysis produced all of the documents responsive to the Document Requests and the Third Party Witnesses produced all of the documents responsive to the Subpoenas.
- In mid-November and early December 2000, Vysis produced to Gen-Probe 20. approximately 100,000 pages of documents.
- Gen-Probe immediately undertook to review these documents and completed its 21. initial review of those documents in early January 2001.
- On January 16, 2001, Vysis produced an additional eight banker's boxes of 22. documents, which boxes contain approximately 20,000 additional pages of responsive documents.
  - Vysis has not yet noticed or taken any depositions in this matter. 23.
- Attached hereto as Exhibit 5 is a true and correct copy of the Scheduling Order 24. issued in this matter.
- Attached hereto as Exhibit 6 is a true and correct copy of a Declaration Norval 25. Galloway, which Vysis filed earlier in this case, wherein Mr. Galloway states that he is Vysis' primary in-house patent prosecution attorney and that he possesses detailed knowledge about the patent-in-suit.

COOLEY GODWARD LLP

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Attached as Exhibit 7 to this Declaration is the original copy of Gen-Probe's 26. [Proposed] Second Amended Complaint.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct and that I executed this declaration in San Diego, California on January 19, 2001.

Stephen P. Swinton

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